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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/894,351	10/27/97	REDECKER	K 306.35565X00

PM52/1130  
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EXAMINER
MILLER, E

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 11/30/98

**Please find below and/or attached an Office communication concerning this application or  
proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/894,351

Applicant(s)

Redecker et al.

Examiner

M. J. L.

Group Art Unit

3681

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-25 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
  - ☐ received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18 and 25, drawn to compositions, classified in Class 149, subclass 36.
- II. Claims 19-22, drawn to methods of making, classified in Class 264, subclass 3.4.
- III. Claim 23, drawn to a device, classified in Class 280, subclass 741.
- IV. Claim 24, drawn to a method of use, classified in Class 60, subclass 219.

2. The inventions are distinct, each from the other, for the following reasons:

Under the PCT rules, applicants may elect a plurality of inventions as to one class of invention, such as compositions, or a plurality of classes of invention as to one species. Applicants are required to make such election. Should applicant desire to elect inventions including Group IV (claim 24 thereof is currently non-statutory as it contains no method step) applicant is required to present at least one proper method of use claim for examination.

Both Groups I and II contain a plurality of species of invention as follows.

Group II contains methods of A) mixing, B) compressing, and C) coating. Applicants are required to elect a single species from the methods of making from this group of inventions, should applicants elect the plurality of classes of invention option.

Because these inventions are distinct and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed, 37 C.F.R. 1.143.

3. Applicant is required under 35 U.S.C. 121 to elect a single, ultimate, disclosed species of Group I for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic or subgeneric. This requirement is on the basis of an unduly burdensome search, MPEP 809.02(d) and/or Markush practice, MPEP 803.02. The single ultimate species shall be one specific composition as in a single example. This is further because the claims are so indefinite that species cannot be determined at this time. This is further because, as from the PCT preliminary examination, the broadest composition claims in Group I are not novel. Thus, there is no common, patentable technical feature which properly links the Groups of invention.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a

listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added subsequently, applicant must indicate those readable on the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if one of the inventions is found unpatentable over the prior art, the evidence or admission will also be applicable under 35 U.S.C. 103 as to the other invention.


4. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163.

Examiner Miller may normally be reached daily, except alternate Fridays, from 8:30 AM to 6 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor, Mr. Jordan, can be reached at (703) 306-4159. The Group fax number is (703) 306-4195.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 306-4177.

Miller/em  
November 29, 1998

  
EDWARD A. MILLER  
PRIMARY EXAMINER  
ART UNIT 3641